

REMARKS

I. Summary of the Office Action

Claims 1-79 are pending in this application.

Claims 12, 27, 36-39, 54, 56, 57, 72, 74, and 75 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alcorn et al. U.S. Patent No. 6,104,815 (hereinafter "Alcorn").

Claims 1, 2, 4-11, 14-17, 19-26, 28-35, 40, 41, 43-53, 58, 59, 61-71, and 76-79 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Paravia et al. U.S. Patent 6,508,710 (hereinafter "Paravia").

Claims 13, 55, and 73 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alcorn in view of Paravia.

Claims 3, 18, 42, and 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Paravia in view of Alcorn.

II. Summary of Telephonic Interview

The Examiner and the undersigned conducted a telephonic interview on June 22, 2004. The undersigned wishes to thank the Examiner for the courtesies extended during the interview.

Generally, the Examiner and the undersigned discussed the obviousness rejection of claim 12 and the Examiner's

contention that "absence the criticality of the location determination being made in the casino gaming server versus the remote user equipment, the claimed invention is obvious" (Office Action, page 16, lines 21-23). The undersigned and the Examiner did not come to an agreement. Detailed arguments in support of applicants' position will be presented below.

The Examiner and the undersigned also discussed whether the combination of Paravia and cookies shows or suggests the features of claims 1 and 14. The undersigned and the Examiner did not come to an agreement. Detailed arguments in support of applicants' position will be presented below.

III. Summary of the Examiner's July 29, 2004 Interview Summary

The Examiner maintains the rejections of the Office Action and more clearly stated the rationale used in the rejection claims 1 and 14.

IV. Summary of Applicants' Reply

The Examiner's rejections are respectfully traversed.

V. Applicants' Reply to the § 103(a) Rejection Over Alcorn

Claims 12, 27, 36-39, 54, 56-57, 72, 74, and 75 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alcorn. The Examiner's rejection is respectfully traversed.

Applicants' independent claims 12, 27, 54, and 72 are directed to systems, a method, and machine-readable instructions that enable user equipment to verify whether it is located in a geographic location where wagering is allowed. An integrated receiver decoder is used to receive blackout information, where the blackout information indicates geographic areas that prohibit wagering. Information that indicates the geographic location of the user equipment is obtained and the user equipment compares the location information to the blackout information to determine whether the user equipment is located in a geographic location where wagering is allowed.

The Examiner concedes that Alcorn fails to show or suggest using remote terminals to compare location information to blackout information to determine whether user equipment is located in a geographic location where wagering is allowed. Nevertheless, the Examiner contends that applicants' invention would have been obvious over Alcorn. The Examiner, however, has failed to provide the requisite motivation to modify Alcorn.

The Examiner first states that "Alcorn's apparatus and [applicant's claimed] invention perform the same function" (Office Action page 4, lines 22-23). Even if this were the case, Alcorn teaches a different means for implementing the function than that specified by applicants' claims. Therefore, the mere fact that Alcorn and applicants' claims may perform

similar functions has no relevance as to whether it would have been obvious to modify Alcorn to perform applicants' claimed invention.

The Examiner further states that because applicants' specification teaches that the location determination may be made either in a network server or on remote terminals, there is no criticality as to where the location determination is made and therefore the claimed invention is rendered obvious. Basing a rejection solely on a lack of criticality, however, is improper as a matter of law.

It is well settled that the Examiner has the initial burden to establish a *prima facie* case of obviousness. The Examiner here, however, has failed to provide any evidence to show why one of ordinary skill in the art would be motivated to modify Alcorn to achieve applicant's invention. *In re Kotzab*, 55 USPQ2d 1313, 1316-1317 (Fed. Cir. 2000) ("[e]ven when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.")

Instead of providing evidence of a motivation to modify Alcorn's location determination step, the Examiner merely points to a lack of criticality as to where the location determination is made in applicants' claims. Criticality, however, is a secondary consideration that an applicant can use

to rebut a *prima facie* case of obviousness. See MPEP § 2144.05(III). A lack of criticality here provides no motivation to one skilled in the art to modify Alcorn to achieve applicants' invention.

Furthermore, applicants believe that the Examiner may be employing hindsight reconstruction in modifying Alcorn to achieve applicants' invention. The Examiner is relying on applicants' own specification, which states that the location determination may be made either in a network server or on remote terminals, in support of the obviousness rejection. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See *Para-Ordnance Manufacturing, Inc. v. SGS Importer International, Inc.* 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) ("Obviousness may not be established using hindsight or in view of teachings or suggestions of the inventor.").

Moreover, applicants would also like to point out that Alcorn also fails to show or suggest using remote terminals to receive blackout information. The Examiner contends that Alcorn shows receiving blackout information with remote terminals in FIG. 5 and at column 7, lines 8-31 and column 8, lines 26-41. Applicants respectfully disagree. As specified in the claims, blackout information indicates geographic regions that prohibit wagering.

FIG. 5 of Alcorn is simply a block diagram showing various components of a remote terminal. The corresponding description of FIG. 5 at column 8, lines 26-41 describes various features of the remote terminal. For example, the description describes how GPS position and time data can be encrypted to prevent tampering. However, nothing in the diagram of FIG. 5 or in its accompanying description shows or suggests that blackout information, which indicates geographic regions that prohibit wagering, is received by the remote terminal.

Column 7, lines 8-31 of Alcorn refers to processes that occur at a server, not at a remote terminal. The server receives information from the remote terminal, processes it, and then returns a signal to the remote terminal indicating whether the user is authorized to play. However, this portion of Alcorn fails to show or suggest that blackout information, which indicates geographic regions that prohibit wagering, is received by the remote terminal.

In view of the foregoing, Alcorn also fails to show or suggest using remote terminals to receive blackout information that could be used in such a determination.

Accordingly, because Alcorn fails to show all of applicants' claimed features, and because the Examiner has failed to point out the requisite motivation for modifying Alcorn to achieve applicants' claimed invention, independent

claims 12, 27, 54, and 72 and dependent claims 36-39, 56-57, 74, and 75 should be found to be allowable over Alcorn.

VI. Applicants' Reply to the § 103 Rejection of
Claims 1, 2, 4-11, 14-17, 19-26, 29-35, 40,
41, 43-53, 58, 59, 61-71, and 76-79 Over Paravia

Claims 1, 2, 4-11, 14-17, 19-26, 29-35, 40, 41, 43-53, 58, 59, 61-71, and 76-79 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Paravia. The Examiner's rejection is respectfully traversed.

Applicants' independent claims 1, 14, 16, 29, 40, 58, 76, and 78 are directed to restricting wagering access on user equipment. When a determination is made that the user equipment is in a location where wagering is allowed, a location verification token is provided to the user equipment. The location verification token includes content that indicates that the user equipment is in a location where wagering is allowed. Wagering access is restricted when either the user equipment does not have a valid token (claims 1, 16, 40, and 58) or a token is not stored on the user equipment (claims 14, 29, 76, and 79).

The Examiner acknowledges the novelty of claims 1, 14, 16, 29, 40, 58, 76, and 78 over Paravia and concedes that Paravia fails to show applicants' features of (a) providing the user equipment with a location verification token when it is

determined that the user equipment is in a location where wagering is allowed and (b) restricting wagering access when either the user equipment does not have a valid token or a token is not stored on the user equipment.

The Examiner, however, contends that it would have been obvious to modify Paravia to include a "cookie" on a player's gaming device to achieve applicants' invention. Applicants respectfully disagree.

In the April 19, 2004 Office Action, the Examiner's alleged motivation for making such a modification to Paravia was to bypass an entry screen or to facilitate the login process. See Office Action, page 13. In the June 22, 2004 telephone interview, the undersigned argued that even if the alleged motivation were valid, the resultant modification to Paravia would not result in applicants' claimed invention. More specifically, applicants argued that if cookies were included in Paravia to facilitate the login process or to bypass an entry screen, this modification of Paravia would still fail to show or suggest (a) providing the user equipment with a location verification token when it is determined that the user equipment is in a location where wagering is allowed, where the token includes content that indicates that the user equipment is in a location where wagering is allowed, (b) using the interactive wagering application to verify whether the location verification

token is valid, and (c) restricting wagering access when the user equipment does not have a valid location verification token as specified by claims 1, 16, 40, and 58.

In response to applicants' argument, the Examiner indicated in the June 22, 2004 telephone interview that the rationale used in the April 19, 2004 Office Action could have been more clear. In the Examiner's July 29, 2004 Interview Summary, the Examiner restated the motivation as follows:

[O]nce the location verification process [of Paravia] has been completed the first time, then a cookie could be placed on the user device such that the location verification process would be bypassed on subsequent connections so that the player could go directly into the gaming system.

Interview Summary, continuation sheet, lines 17-19. Paravia, however, does not perform the location verification process prior to allowing a player to enter the gaming system. As shown in FIG. 12 and as described in the accompanying description of Paravia, Paravia only performs the location verification process after a player enters gaming selections (i.e., places a wager). See also FIGS. 14 and 15 of Paravia. Paravia states that this arrangement "insures that the player is within the boundaries of a particular location, such as a state to comply with various laws and regulations." Paravia, column 22, lines 30-32.

The Examiner's proposed modification to Paravia, however, would no longer insure that a player is located in an

authorized location. For example, adding cookies to Paravia would allow a player to move his computer to a location where wagering is not authorized and allow the player to place wagers because the location verification process would be bypassed. Therefore, Paravia teaches away from such a modification.

Accordingly, because the Paravia teaches away the Examiner's proposed modification, and because the Examiner has failed to provide any objective evidence of a motivation to modify Paravia, independent claims 1, 14, 16, 29, 40, 58, 76, and 78 and dependent claims 2, 4-11, 15, 17, 19-26, 30-35, 41, 43-53, 59, 61-71, 77, and 79 should be found to be allowable over Paravia.

VII. Applicants' Reply to the Remaining § 103 Rejections

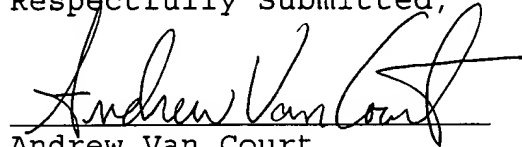
Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatenatable over Paravia. Claims 13, 55, and 73 are rejected under 35 U.S.C. § 103(a) as being unpatenatable over Alcorn in view of Paravia. Claims 3, 18, 42, and 60 are rejected under 35 U.S.C. § 103(a) as being unpatenatable over Paravia in view of Alcorn. Each of these rejections is respectfully traversed.

At least because applicants have demonstrated in the foregoing that independent claims 1, 12, 16, 27, 40, 54, 58, and 72 are allowable, dependent claims 3, 13, 18, 28, 42, 55, 60, and 73 should also be allowable.

VIII. Conclusion

The foregoing demonstrates that claims 1-79 are allowable. Applicants respectfully submit that this patent application is in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Andrew Van Court", is written over a horizontal line.

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